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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/825,585 04/01/97 YOSHIDA

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005514 WM01/1019
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NEW YORK NY 10112

EXAMINER

ENG. G

ART UNIT

PAPER NUMBER

2643

DATE MAILED:

10/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/825,585

Applicant(s)

Yoshida

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 2, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 38 20) ☐ Other:

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 10/2/2001 (paper no. 37) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/825,585 is acceptable and a CPA has been established. An action on the CPA follows.

Information Disclosure Statement

2. The information disclosure statement filed 10/2/2001 (paper no. 38) has been considered.

Claim Rejections - 35 USC § 112

3. Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the communication protocol" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 is rejected as the same reasons set forth in claim 2.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US PAT.5,517,557) in view of Reyes et al. (US PAT. 5,361,296 hereinafter Reyes).

Regarding claim 1, Tanaka discloses a communication apparatus for executing a plurality kinds of communication protocols (i.e., facsimile protocol or communication protocol for setting up voice communication) comprising a detecting circuit (19) to detect ID information for identifying a communication apparatus at a calling station before a start of communication with the communication apparatus at the calling station (col. 6 lines 2-5), a memory (4a) for storing various operations including information of a communication system of the communication apparatus at the calling station (col. 5 lines 12-14), and a control circuit for conducting communication based on a communication protocol corresponding to the information stored in said memory according to whether or not the ID information detected by said detector circuit is stored in said memory when communication is to be conducted in response to a calling signal (col. 6 lines 17-29). Note while Tanaka discloses that the communication apparatus is a facsimile apparatus (abstract). Thus, the communication protocol is a facsimile protocol. Tanaka differs from the claimed invention in not specifically teaching that the communication apparatus to execute a plurality kinds of facsimile

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protocols. However, Reyes teaches to select a facsimile protocol from a plurality of protocols based upon ID information, i.e., ring type (col. 4 line 55 through col. 6 line 45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tanaka in having the communication apparatus to execute a plurality kinds of facsimile protocols, as per teaching of Reyes, because it improves the compatibility so that the communication device is capable of executing different instruction sets of facsimile mode..

Regarding claim 2, Tanaka teaches to register the ID information of the communication apparatus at the calling station and the information of the communication system in said memory in accordance with the communication protocol (col. 6 lines 19-20).

Regarding claim 3, Tanaka discloses that the ID information for identifying the communication apparatus at the calling station is telephone number information (col. 6 lines 23-24) such that the information of the communication system of the communication apparatus at the calling station is stored in said memory in associated with the telephone number information sent between the calling signal (col. 6 lines 24-29).

Regarding claim 4, Tanaka discloses to change with a type of modem used by the communication apparatus (col. 6 lines 26-29).

Regarding claim 5, the particular type of protocols merely a matter of design choice and an obvious modification to the apparatus of Tanaka since it would be advantageous to have the apparatus operating in accordance with the standards set by CCITT.

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Regarding claim 6, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 7, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 5.

6. Claims 11-13, 17-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US PAT.5,517,557) in view of Takehiro et al. (US PAT. 5,274,467 hereinafter Takehiro).

Regarding claim 11, Tanaka discloses a communication apparatus for executing a plurality kinds of communication protocols (i.e., facsimile protocol or communication protocol for setting up voice communication) comprising a receiver circuit (19) to receive ID information for identifying a communication apparatus at a calling station before a start of communication with the communication apparatus at the calling station (col. 6 lines 2-5), a control circuit for conducting communication based on a communication protocol corresponding to the ID information according to whether or not the ID information is received when communication is to be conducted in response

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to a calling signal (col. 6 lines 17-29). Tanaka differs from the claimed invention in not specifically teaches to conduct communication according to whether or not the ID information has been received by a receiver circuit. However, it is old and well known in the art for determining whether a receiving device receives an ID information from transmitting device from a remote side before conducting communication, for example see Takehiro (figure 10 and col. 10 lines 9-59). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tanaka in conducting communication according to whether or not the ID information has been received by a receiver circuit, as per teaching of Takehiro, because it improves efficiency in transmitting information so that the receiving device is capable of being informed from a specific party.

Regarding claim 12, Tanaka discloses the receiver circuit receiving the ID information between receiving successive calling signals (col. 6 lines 1-4).

Regarding claim 13, Tanaka discloses the communication apparatus further comprising a memory (4a) for storing various operations including information of a communication system of the communication apparatus at the calling station (col. 5 lines 12-14), wherein said control circuit selects at least one communication protocol based on the ID information received by said receiver circuit and the registered ID information stored in the memory (col. 6 lines 24-29).

Regarding claim 17, Tanaka discloses that the ID information received by the receiver circuit is a telephone number of the communication apparatus at the calling station (col. 6 lines 23-24).

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Regarding claim 18, the limitations of the claim are rejected as the same reasons set forth in claim 11.

Regarding claim 19, the limitations of the claim are rejected as the same reasons set forth in claim 12.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 13.

Regarding claim 24, the limitations of the claim are rejected as the same reasons set forth in claim 17.

7. Claims 14-16 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US PAT.5,517,557) in view of in view of Takehiro et al. (US PAT. 5,274,467 hereinafter Takehiro) as applied in claims above, and further in view of Williams (US PAT. 5,450,483).

Regarding claims 14-16, the combination of Tanaka and Takehiro differs from the claim invention in not specifically teaching to automatically update the communication protocols stored in the memory when a predetermined time has been counted or a predetermined number of communications has been counted. However, Williams teaches a method for controlling calls in a telecommunication network comprising the steps of automatically updating parameter in a database when a predetermined number of communications has been counted (col. 1 lines 25-47) or a predetermined time has been counted (col. 1 lines 48-63). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination

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of Tanaka and Takehiro in updating the communication protocols stored in the memory when the predetermined time has been counted or the predetermined number of communications has been counted, as per teaching of Williams, because it controls calls whose call identities belong to a common set of call identities.

Regarding claims 21-23, the limitations of the claims are rejected as the same reasons set forth in claims 14-16.

Response to Arguments

8. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

Arlington, VA., Sixth Floor (Receptionist).

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



GEORGE ENG

October 12, 2001